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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,864	03/22/2001	Takashi Kobayashi	56937-026	3329

7590 11/30/2004  
McDERMOTT, WILL & EMERY  
600 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER

HUYNH, KIM T

ART UNIT	PAPER NUMBER
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2112

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/813,864

Applicant(s)

KOBAYASHI ET AL.

Examiner

Kim T. Huynh

Art Unit

2112

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Receipt Acknowledgement***

1. Receipt is acknowledged of the request filed on 28<sup>th</sup> of October 2004 for a request for continued examination (RCE) under 37 CFR 1.114 based on the application No. 09/813,864, which the request is acceptable and an RCE has been established. No claims 1-4 have been cancelled. Claims 5-8 have been amended. Currently, claims 5-8 are pending in this application.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Garrett (US Patent 5,594,873)

As per claims 5, 7, Garrett discloses an information processing apparatus

(method), comprising:

- A network-card-recognizing device that recognizes a plurality of network cards mounted therein; (col.4, lines 22-27), wherein expansion devices implies network cards)

- A degree-of-demountability storage device that stores therein the degrees of demountability of the plurality of network cards recognized by the network-card-recognizing device; and (col.4, lines 22-37), wherein identify type of expansion devices implies degrees of demountabilities of network cards)
- An information processing apparatus identifier production device that produces an identifier for the information processing apparatus based on an identifier of a network card having the lowest degree of demountability among the plurality of network cards stored in the degree-of-demountability storage device. (col.1,40-col.2, line 60)

As per claim 6, 8, Garrett discloses wherein the demountability is a facility of structurally detaching a network card, a frequency of uses, or a type of card. (col.4, lines 31-32)

#### ***Response to Amendment***

4. Applicant's amendment filed on 10/28/04 have been fully considered but are not place an application in condition for allowance.

a. In response to applicant's argument that Garrett does not disclose using the identifier of one card to produce the identifier of another card based on a demountability characteristic of the one card. Examiner respectfully disagrees. As Garrett notes at (col.1,40-col.2, line 60) discloses each expansion device asserts an identification signal for preset time depending on the type of expansion device(this implies based on network card). Furthermore, Garrett discloses each of expansion devices configures as

different type of adapter cards and each of these card includes identification signal which the host computer identifies each expansion device by the length or duration that the identification signal is negated (this implies producing an identifier for a device). Thus, the prior art teaches the invention as claimed and the amended claims do not distinguish over the prior art as applied.

### **Conclusion**

5. *Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Huynh whose telephone number is (571)272-3635 or via e-mail addressed to [kim.huynh3@uspto.gov]. The examiner can normally be reached on M-F 9.00AM- 6:00PM.*

*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on (571)272-3632 or via e-mail addressed to [mark.rinehart@uspto.gov]. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9306 for regular communications and After Final communications.*

*Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-2100.*

Kim Huynh

Nov. 26, 2004



**TIM VO  
PRIMARY EXAMINER**